



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/240,062	01/29/1999	THOMAS GRAF	2565/45	6866
26646	7590	01/29/2004		
KENYON & KENYON ONE BROADWAY NEW YORK, NY 10004			EXAMINER CHOI, STEPHEN	
			ART UNIT 3724	PAPER NUMBER 27
DATE MAILED: 01/29/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/240,062

Applicant(s)

GRAF ET AL.

Examiner

Stephen Choi

Art Unit

3724

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,5,19 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5,19 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 29 December 2003 has been entered.

### ***Claim Rejections - 35 USC § 112***

2. Claims 19-20 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no support in the specification for the claimed method of manufacturing a filter element for a dialyzer set forth in claims 19-20.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 5 and 20, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Koehler (US 1,965,464).

Koehler discloses all the recited steps of the invention including:

- a) transporting a fiber bundle strand using at least one feed element (52, 53);
- b) pre-cutting the fiber bundle strand into unbound partial bundles, the unbound partial bundles having a length (74, 75);
- c) releasing the unbound partial bundles from the at least one feed element (page 2, lines 72-81);
- d) gripping the unbound partial bundles using at least one gripping element (65, 66);
- e) releasing the unbound partial bundles from the at least one gripping element (page 2, lines 82-92);
- f) placing the unbound partial bundles having the same length in a first collection trough (26) of a collection device (25);
- g) rotating the collection device after the first collection trough is filled and placing the unbound partial bundles in a further collection trough (page 2, lines 36-39) of the collection device. Element 26 adjacent to the first collection trough (26) is construed as being "a further collection trough". It is noted that the claim does not preclude a step of bounding partial bundles, and further, the claim does not call for a step of rotating the collection device while the unbound partial bundles in the first collection trough remains unbounded.

***Claim Rejections - 35 USC § 103***

Art Unit: 3724

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1 and 19, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Koehler (US 1,965,464).

Koehler discloses the invention substantially as claimed including a step of repeating steps a) to f) for the required number of unbound partial bundles (page 2, lines 36-39). Koehler fails to disclose repeating the steps a) to f) until a required thickness of the fiber bundle is obtained. However, it would have been an obvious matter of design choice to one having ordinary skill in the art at the time the invention was made to repeat the steps a) to f) until the required thickness of the fiber bundle is obtained (e.g., a required manufacturing amount of bundles) in order to complete a required amount for each containers or collection boxes. It is noted that the claim does not call for the required thickness of the bundles in each through, and further, the claim does not preclude a step of bounding partial bundles. It merely requires steps a) to f) being repeated to place the required number of unbound partial bundles in the first collection trough. Each element 26 is construed as being "a first collection trough" of the collection device (25).

### ***Response to Arguments***

7. Applicant's arguments filed 29 December 2003 have been fully considered but they are not persuasive.

Art Unit: 3724

Applicant contend that Koehler does not teach a step of pre-cutting a fiber bundle strand since Koehler, on page 2, lines 42-51 and 93-96, describes that the ends of the threads are cut after the threads are at least clamped, folded, and bound together. Applicants further contend that Koehler does not disclose, or even suggest the step of placing the unbound partial bundles having the same lengths in the same collection trough of a collection device until the collection trough is filled prior to rotating the collection device and the step of placing the unbound partial bundles in the same collection trough of a collection device until a required thickness of the fiber bundles is obtained in the collection trough.

The examiner respectfully disagrees. Koehler teaches that strands are clamped and severed by cutoff knives (74, 75) into unbound partial bundles. The severed portion are folded (page 2, lines 125-130) and then bounded together (page 3, lines 5-8). Furthermore, Koehler does teach the step of placing the unbound partial bundles having the same lengths in the same collection trough of a collection device until the collection trough is filled prior to rotating the collection device as set forth above. Koehler teaches, on page 2, lines 36-39, the step of rotating the element 25 after one of the elements 26 is filled and placing the unbound partial bundles in adjacent element 26. Moreover, it is respectfully submitted that repeating certain manufacturing steps to fill a collection container in order to complete required amount of products for each containers or collection boxes in any manufacturing environment is old and well known. Thus, the examiner's conclusion of obviousness is only based on the knowledge which

Art Unit: 3724


was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned from the applicant's disclosure.

***Conclusion***

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to S. Choi whose telephone number is 703-306-4523. The examiner can normally be reached on Monday thru Friday between 9am and 5pm. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703-308-1082.

In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9306. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-1148.

SC  
January 23, 2004

  
**STEPHEN CHOI**  
**PRIMARY EXAMINER**